

**Remarks/Arguments**

**Objection to the Drawings under 37 CFR 1.83(a)**

The Examiner objected to the drawings under 37 CFR 1.83(a) for failing to show the coding device recited in Claim 8. Applicants have cancelled Claim 8 and request that the objection be removed.

**Claim Rejections under 35 U.S.C. §102 (Anticipation)**

The Examiner rejected Claims 1-6 under 35 USC §102 as being anticipated by U.S. Patent No. 5,488,886 (Mohr). Applicants respectfully traverse the rejection

Applicants have cancelled Claim 1 and amended Claims 2-6 to depend from Claim 9. Claim 9 is not anticipated by Mohr. Claims 2-6, dependent from Claim 9, enjoy the same distinction from the cited prior art. The rejection should be removed.

**Claim Rejections under 35 U.S.C. §103 (Obviousness)**

The Examiner rejected Claims 1-9 under 35 USC §103 as being unpatentable over European Patent No. 0544181 (Niesporak). Applicants respectfully traverse the rejection.

“To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some suggestion or motivation to modify the reference. Second, the reference(s) must provide a reasonable expectation of success. The third requirement for a *prima facie* case of obviousness is that the reference must teach or suggest all limitations of the claim at issue. *The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.*” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

**Niesporak does not measure a distance between a specimen and a knife**

Claim 9 recites: the arrangement of the light barrier is such that the relative motion *between the knife and the specimen* (emphasis added) penetrates the light barrier and thereby ascertains a spacing *between the knife and the specimen* (emphasis added).” Niesporak teaches a

different type of mechanism (a limiter) performing a different function. The limiting device measures the limit of a coarse feed movement of the sample holder. That is, Niesporak uses the limiting device to tell the sample holder at what point to stop the coarse feed movement, at which time a fine feed movement is presumably initiated. Therefore, Niesporak is not measuring a spacing between a specimen and a knife, as recited in Claim 9. Instead Niesporak is defining a predetermined stopping point for the specimen holder. There is no explicit or implicit teaching that the operation of the limiter is concerned with or is responsive to the presence of a sample in the holder. That is, the stopping point is independent of any sample in the holder. Alternately stated, the stopping point of the holder is predetermined and must be selected to account for any possible configuration of samples in the holder. Given this lack of reference to any sample that may be present, Niesporak clearly cannot ascertain the spacing between the sample and the knife.

Niesporak does not teach, suggest, or motive ascertaining a spacing between a sample and the knife. The Examiner has cited U.S. Patent No. 5,488,886 (Mohr) as providing motivation to modify Niesporak to replace the limiting device of Niesporak with a light barrier. Mohr does not cure the defects of Niesporak regarding ascertaining a spacing. Niesporak does not teach, suggest, or motivate all the limitations of the claim at issue and therefore, cannot form a *prima facie* case of obviousness with respect to Claim 9.

Mohr is not analogous to Niesporak or the present invention

Mohr teaches a hydraulic, guillotine, bench cutting machine for cutting sheets of material stacked on a bench (Abstract and Figure 1). That is, Mohr is cutting a plurality of longitudinal sheets orthogonal to the face/surface of the sheets. Specifically Mohr teaches cutting stacked sheets of paper, cardboard, or similar material (col. 5, lines 39-41). Niesporak and the present invention address slicing of a specimen in a microtome. In addition to the difference in cutting operations (chopping sheets versus slicing a cross section from a piece), there are orders of magnitude difference between the stack materials cut by Mohr and the slices produced by the present invention. For example, the slices are on the order of micrometers and Mohr's stacks are typically measured in feet and inches. Mohr and the present invention are not in the same field of art.

Mohr and the present invention are solving different problems

Mohr is specifically solving a problem related to operator safety and increasing the rate of an industrial process (col. 1, lines 9-19). Mohr uses a detector to note when a holdfast beam is in place and to control when the blade is operated: "Cutting can be initiated by pressing two buttons 20 on the front of bench 3. Holdfast beam 8 descends onto the material 1 that is to be cut. The light barrier is electrically connected during the cutting process and specifically once holdfast beam 8 has descended onto material 1 to the hydraulic mechanism that actuates the beam and is accordingly actuated when the material obstructs light 15. Once holdfast beam 8 is resting on the material 1 that is to be cut, blade 7 descends and cuts the material." (col. 6, lines 39-47). That is, the cutting operation does not proceed until the light barrier is broken. Further, Mohr is not concerned with the spatial relationship between the stacked materials and the blade or where the stacked materials are cut. Instead, Mohr is concerned with the spatial relationship between the holdfast beam and the blade so as to control the return motion of the blade.

In contrast, the present invention is solving a measurement and spatial relation problem regarding the specimen (to be cut) and a blade. In particular, the present invention seeks to avoid damaging the blade or the specimen.

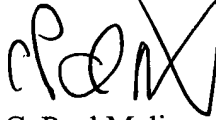
For all the reasons presented above, Niesporak fails to form a *prima facie* case of obviousness with respect to Claim 9. Therefore, Claim 9 is patentable over Niesporak. Claims 2-8, dependent from Claim 9, enjoy the same distinction from the cited prior art. The rejection should be removed.

Attorney Docket No.: LVIP:108US  
U.S. Patent Application No. 10/734,566  
Reply to Office Action of April 28, 2005  
Date: August 26, 2005

**Conclusion**

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Paul Maliszewski'.

C. Paul Maliszewski  
Registration No. 51,990  
Simpson & Simpson, PLLC  
5555 Main Street  
Williamsville, NY 14221-5406  
Telephone No. 716-626-1564

Dated: August 26, 2005  
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